



UNITED STATES
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#24

In re Application of Yuan-Ping Pang :
Serial No.: 09/595,650 :
Filed: June 16, 2000 : PETITION DECISION
Attorney Docket No.: 07039-161001 :

This is in response to applicants' petition, filed August 19, 2002 under 37 CFR 1.144, requesting withdrawal of the restriction requirement set forth by the examiner.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111(b) on June 16, 2000 and claims benefit of provisional application 60/139,845, filed June 18, 1999. The application, as filed, contained claims 1-54. On February 26, 2001, the examiner mailed a restriction requirement dividing the claims into 3 groups, as follows:

Group I. Claims 1-18, 25-31, 33, 35 and 36, drawn to a method of molecular dynamics simulation.

Group II. Claims 37-54, drawn to a simulated metal ion.

Group III. Claims 19-24, 32 and 34, drawn to a method of nanosecond or longer molecular dynamics simulation.

In a response filed May 17, 2001, applicant elected Group II, claims 37-54, without traverse. On August 16, 2001 the examiner mailed a first action on the merits, rejecting all the elected claims.

On December 17, 2001 applicant filed a response including an amendment adding claims 55-72. On April 19, 2002 the examiner mailed an Office action (final rejection) which indicated that claims 55-72 were withdrawn from consideration because they are drawn to the invention of (non-elected) group I.

On June 18, 2002 applicant filed a response after final which included a traversal of the withdrawal of claims 55-72 from consideration. Applicant traversed essentially on the same

grounds presented in the petition. On July 18, 2002 the examiner mailed an Advisory Action maintaining the placement of claims 55-72 in Group I.

DISCUSSION

Applicant argues that the examiner did not provide reasons for withdrawing the disputed claims from consideration. This argument is not persuasive because the examiner did provide a reason, namely that the new claims corresponded to Group I. Group I is distinct from Group II for the reasons stated in the original restriction.

Applicant further argues that claims 55-72 are drawn to an article of manufacture, not a method, and that the same search is required for group II and claims 55-72. This line of argument is not persuasive. Group II was originally drawn to a simulated metal ion, i.e. a presentation of information. The claims were first amended to recite a computer readable medium having this information stored therein, and have most recently been amended to recite a machine having the information stored in its memory. Group I is drawn to a method of molecular dynamics simulation. Claims 55-72 are drawn to a computer readable medium containing computer executable instructions for carrying out the method of Group I. The search required for claims 55-72 is the same search required for Group I, i.e. the prior art must be searched for the method steps of Group I. Group II requires search of the prior art for a machine with data storage means. The question of patentability does not hinge on the information which is stored therein, nor on the method used to generate that information. Thus the search required for Group I, and claims 55-72, is not required for examination of Group II.

DECISION

Applicants's petition is **DENIED** for the reasons set forth above.

The application will be forwarded to the examiner for consideration of the amendment and response filed August 19, 2002.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-4205 or by facsimile transmission at (703) 746-5006.

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